

REMARKS

The above-noted amendments to claim 64 are respectfully submitted in response to the official action dated November 26, 2002.

Claims 64-80 have been rejected as being unpatentable under 35 U.S.C. § 112, second paragraph. The Examiner contends that in claim 64 the terms "facilitates," "highly" and "functionalizing" are vague. However, in view of the above-noted amendments to claim 64, it is respectfully submitted that this objection is no longer appropriate.

Firstly, amended claim 64 no longer includes the words "functionalizing" and "facilitates." The claim now specifically requires that a monomer be included which provides functional groups for crosslinking along with the crosslinking agent therein. There can be no doubt as to the meaning of this conventional term to anyone of ordinary skill in this art.

In this regard, turning to page 19 of the specification, the nature of these monomers is specifically defined and set forth therein. These functionalizing monomers are defined as monomers which provide functional groups for the purpose of crosslinking and as specified on page 19 in paragraph [0050], these monomers are "well known in the art," and the specification then goes on to set forth a more than adequate list of the specific such monomers.

Applicants have, however, not amended the term "highly plasticizing drug" in claim 64. The Examiner's attention is directed to page 13, paragraph [0036] of the specification in which the details and nature of such drugs are specifically set forth. It is believed to be clear from the specification and the definition of this term exactly what these drugs are, and their specific nature. It is therefore believed to be unnecessary to amend this portion of the specification, since one of ordinary skill in this art would have no problem whatsoever determining precisely what these drugs are and what

properties they possess. Since this is a critical element of the present invention, and applicants should not be restricted to the specific list of drugs possessing this well-known and understood feature, it is therefore respectfully requested that this amendment now be accepted in its present form as complying with all of the provisions of § 112.

Claims 64-80 have been provisionally rejected on the basis of obviousness-type double patenting over claims 84-92 of co-pending Application No. 08/883,075. However, since none of the conflicting claims have been patented, and since this is a provisional double-patenting rejection, applicants do not believe that a terminal disclaimer needs to be filed at this time. Applicants offer, however, to file such a terminal disclaimer should those claims issue, and doing so would then clearly obviate this rejection.

Claims 64-80 have been rejected as being anticipated by Mantelle *et al.* The Examiner contends that Mantelle *et al.* teaches a transdermal comprising a liquid active and a polymer free of solvents, citing the abstract and referring to the disclosure of Duro-Tak 87-2852 at column 13, line 34. This is said to be the polymer applicants specify at page 19, Table 2 hereof. Sixty percent is said to be disclosed at column 15, Table 6, and selegiline is specified at 5-25% at column 3, lines 6-18. As to the claimed percentage of crosslinker, the Examiner assumes that Dura-Tak 87-2852 possesses an amount within the claimed range because applicants exemplify its use at page 42, paragraph [0109]. This rejection is respectfully traversed in view of the above amendments and arguments and for the reasons set forth hereinafter.

Attached hereto is a copy of the supplemental declaration under 37 C.F.R. § 1.131 which was filed in applicants' parent Application No. 08/883,075. This declaration was filed in order to swear behind the very same Mantelle *et al.* patent in applicants' parent application, and in fact was apparently accepted by the Examiner, since in an official action dated May 9, 2003, the Examiner has no longer cited Mantelle *et al.* against applicants' parent application.

Applicants appreciate the fact that the declaration in question was filed in applicants' parent application to overcome the same reference, but with respect to different claims. It is submitted, however, that the declaration should be accepted in its present form to also overcome the same reference in applicants' divisional application herein being prosecuted. Applicants have thus demonstrated possession of at least as much of the invention set forth in claims 64-80 as is shown in the Mantelle *et al.* reference, which is clearly sufficient to eliminate Mantelle *et al.* as a properly citable reference herein.

Turning specifically to the declaration itself, it can be seen beginning in paragraph 7 of that declaration that applicants have sworn to the specific facts which demonstrate their reduction to practice of a transdermal delivery system for selegiline in accordance with this invention prior to June 7, 1995, the earliest effective date of Mantelle *et al.* Referring to claim 64, for example, it can be seen that the adhesive utilized in Paragraph 8 of the declaration utilized the acrylic pressure-sensitive adhesive known as GELVA 1753 (Monsanto), which not only includes 32% solid content and self crosslinkable acrylic adhesive containing a hardening monomer comprising methyl acrylate, along with ethyl acetate in the amounts shown, but as can be seen from the attachments thereto included specific embodiments using GELVA 1753 in amounts between 65 and 97% by weight, and the specific ingredients thereof along with a crosslinking agent, and the claimed amount of highly plasticizing drug; namely, selegiline (*i.e.*, from 3 to 35% by weight).

It is also clear that this in the same general range of the amounts of the compound allegedly disclosed by Mantelle *et al.* and relied upon by the Examiner herein.

It is therefore clear that Mantelle *et al.* is no longer properly citable as a reference against this application, and, as was the case in applicants' parent application, it is respectfully requested that reliance upon Mantelle *et al.* now be withdrawn. That being the case, it is further submitted that the present application is clearly in condition for allowance, and such action is therefore

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also respectfully solicited. If, however, for any reason the Examiner still does not believe that such action can be taken at this time, it is respectfully requested that he telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: May 21, 2003

Respectfully submitted,

By 

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